

REMARKS**I. General**

The only issues raised by the present Office Action arise from the rejection of claims 1-21 under 35 U.S.C. 102(e) as anticipated by Tung Loo et al., U.S. Pat. Pub. No. 2002/0143865 (hereinafter *Loo*). Applicant hereby traverses the outstanding rejections of the claims, and request reconsideration and withdrawal of the outstanding rejections in light of the remarks contained herein. A paragraph of the specification has been amended above to correct a typographical error. No new matter has been added by this amendment. Claims 1-21 are currently pending in this application.

II. The Office Action Does Not Address All of the Claims.

Claims 14 and 17 are indicated as rejected in the Office Action Summary and on page 2 of the Office Action. However, these claims are not specifically addressed within the body of the Office Action, as are the other claims, 1-13, 15, 16 and 18-21. Accordingly, Applicant respectfully contends that the rejections of claims 14 and 17 do not comport with Office policy. Specifically, the Examiner is directed that “[i]n accordance with the patent statute, ‘Whenever, on examination, any claim for a patent is rejected , or any objection . . . made’, notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution (35 U.S.C. 132) should be given,” M.P.E.P. § 707. As such the Examiner has not “clearly articulate[d] any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the earliest opportunity,” M.P.E.P. § 706. Applicant therefore requests that the Examiner set forth, in a non-final Office Action, the grounds for rejection with respect to claims 14 and 17, in order that Applicant may have a full and fair opportunity to explore the patentability of these claims.

II. Rejection(s) under 35 U.S.C. §102(e)

Claims 1-21 stand rejected under 35 U.S.C. §102(e) as being anticipated by *Loo*. Applicant respectfully traverses this rejection for at least the following reasons.

A. Relied Upon Reference is Not Necessarily Prior Art.

The cited reference, *Loo* is a published U.S. patent application having a filing date of November 20, 2001, and claims the benefit of priority to two provisional patent applications, a first having a filing date of December 22, 2000 and a second, having a filing date of April 20, 2001. Whereas, only one of these filing dates, the filing date of the provisional filed on December 22, 2000, predates the March 30, 2001 filing date of the present application, it appears that the Office Action uses the date of the December 22, 2000 provisional patent application as the §102(e) date of *Loo*. This would seem to be consistent with the Examination Guidelines for 35 U.S.C. § 102(e), as amended by the American Inventors Protection Act of 1999, and further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002, and 35 U.S.C. § 102(g) (see e.g., Section IV “Examination Procedures under 35 U.S.C. §§ 102(e) and 374” thereof). However, Applicant respectfully submits that only the subject matter that was actually present in the December 22, 2000 provisional patent application (referred to hereafter as “*December 2000 Provisional*”) is afforded the earlier date of December 22, 2000. The provisions of M.P.E.P. §2136.03(III) require that “[t]he 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions **if** the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.” (Emphasis in the original.) In this case, the Examiner has not provided applicant with a copy of the *December 2000 Provisional*, nor cited or indicated what portions of the *December 2000 Provisional* are relied upon as providing the called for support for the subject matter relied upon to make the rejection of claims 1-21. Therefore, Applicant respectfully requests that the Examiner provide applicant with a copy of the *December 2000 Provisional* and an indication as to what portions of the *December 2000 Provisional* provide the called for support for the subject matter relied upon to make the rejection of the present claims, in a non-final Office Action, in order that Applicant may have a full and fair opportunity to explore the patentability of the claims. Otherwise, Applicant requests that the rejections be withdrawn, as it is unclear as to whether the relied upon teachings of *Loo* are proper prior art under 35 U.S.C. § 102(e).

B. The recited reference does not teach all claim elements.

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. §2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that the rejection does not satisfy at least these requirements.

Independent claim 1 recites “means ... for evaluating a need for a risk acceptance agreement from said accessing user for a requested service” and “means ... for obtaining approval, if required, of said risk acceptance agreement from said accessing user.” *Loo* does not disclose or suggest at least these elements. *Loo* is silent concerning any sort of risk acceptance agreement, much less evaluating a need for such a risk acceptance agreement from an accessing user or obtaining approval of such a risk acceptance agreement, particularly from the accessing user. The Examiner is respectfully encouraged to review the paragraph beginning on line 8 of page 5, and the paragraph beginning on line 3 of page 8, of the present specification for a discussion of the risk acceptance agreement and its acceptance by the accessing user. Whereas, *Loo* does not teach, or suggest the above recited elements of claim 1, Applicant respectfully asserts that at least for this reason independent claim 1 is patentable over the 35 U.S.C. § 102 rejection of record. Furthermore, there are great differences between claim 1 and the cited reference, and a person of ordinary skill in the art considering the cited reference would not find these differences obvious.

Each of claims 2-6 ultimately depend from independent claim 1, and thus each inherits all limitations of claim 1. Therefore, for at least the reasons advanced above in addressing the anticipation rejection of claim 1, each of claims 2-6 set forth features and limitations not recited by *Loo*. Thus, Applicant respectfully asserts that claims 2-6 are also patentable over the 35 U.S.C. §102 rejection of record.

Independent claim 7 recites “obtaining, online, all determined approvals from said requesting user” (emphasis added). Applicant respectfully contends *Loo* does not disclose or suggest at least this element. *Loo* is silent concerning any sort of approvals from the requesting user. *Loo* only discloses that individual users can be allowed to:

“(1) add themselves to the user directory by filling out customized forms, (2) modify personal or professional information about themselves (such as addresses, personal preferences, or name changes), (3) change a piece of information in their identity profiles that can determine their access rights, or (4) allow someone else to log in as their temporary substitute while they are out of the office or on vacation” (see paragraph [0109] of *Loo*); or

“(1) self-subscribe to and unsubscribe from groups, (2) view the groups that they are eligible to join or have joined, and (3) request subscription to groups that have access to the applications they need” (see paragraph [0113] of *Loo*).

Again, the Examiner is respectfully encouraged to review the paragraph beginning on line 8 of page 5, and the paragraph beginning on line 3 of page 8, of the present specification. Therein, the Examiner will find a discussion of obtaining approvals from the accessing user, such as acceptance of the risk acceptance agreement. Whereas, *Loo* does not teach, or suggest, obtaining online approvals from the requesting user, Applicant respectfully asserts that independent claim 7 is patentable over the 35 U.S.C. § 102 rejection of record. Furthermore, there are great differences between claim 7 and the cited reference, and a person of ordinary skill in the art considering the cited reference would not find these differences obvious.

Each of claims 8-18 ultimately depend from independent claim 7, and thus each of claims 8-18 inherits all limitations of claim 7. Therefore, for at least the reasons advanced above in addressing the anticipation rejection of claim 17, each of claims 8-18 set forth features and limitations not recited by *Loo*. Thus, Applicant respectfully asserts that claims 8-18 are also patentable over the 35 U.S.C. §102 rejection of record.

Independent claim 19 recites “an enterprise database including information...including ...risk acceptance requirements for a service for an identified user” (emphasis added). *Loo* does not disclose, or suggest, this element. As discussed above, *Loo* is silent concerning any sort of risk acceptance requirements, much less inclusion of such information in an enterprise database, particularly its inclusion as “risk acceptance requirements for a service for an identified user” (emphasis added). The Examiner is again respectfully encouraged to review the paragraph beginning on line 8 of page 5, and the paragraph beginning on line 3 of page 8, of the present specification for a discussion of the

risk acceptance agreement and its provisioning to the accessing user. Whereas, *Loo* does not teach, or suggest the above recited elements of claim 19, Applicant respectfully asserts independent claim 19 is patentable over the 35 U.S.C. § 102 rejection of record.

Furthermore, there are great differences between claim 19 and the cited reference, and a person of ordinary skill in the art considering the cited reference would not find these differences obvious.

Each of claims 20 and 21 depend directly from independent claim 19, and thus each inherits all limitations of claim 19. Therefore, for at least the reasons advanced above in addressing the anticipation rejection of claim 19, Applicant respectfully contends each of claims 20 and 21 set forth features and limitations not recited by *Loo*. Thus, Applicant respectfully asserts that claims 20 and 21 are also patentable over the 35 U.S.C. §102 rejection of record.

III. Conclusion

For at least the reasons given above, Applicant submits that the pending claims distinguish over the cited reference under 35 U.S.C. §102. Accordingly, Applicant submits that this application is in full condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10013359-1 from which the undersigned is authorized to draw. Applicant respectfully requests that the Examiner call the below listed attorney if the Examiner believes that the attorney can helpful in resolving any remaining issues or can otherwise be helpful in expediting prosecution of the present application.

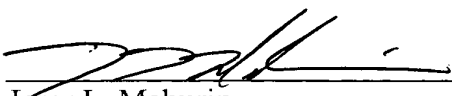
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Date of Deposit: December 28, 2004

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